

### **REMARKS/ARGUMENTS**

The Applicant acknowledges, with thanks, receipt of the Office Action mailed December 31, 2003. Claims 1-18 are now pending and stand rejected.

**I. Claims 1, 2, 5, 10, 11, and 14 are in condition for allowance under 35 U.S.C. 102(e) over Bennett.**

Claims 1, 2, 5, 10, 11, and 14 were initially rejected under 35 U.S.C. 102(e) over U.S. Patent No. 6,419,579 to Bennett (the Bennett patent). Withdrawal of these rejections are requested for the following reasons.

Independent claim 1, is limited to a gaming machine. The machine includes a means adapted to display an array of symbols randomly selected from a set of symbols. The machine further includes a means adapted to pay winnings on an occurrence of predetermined winning combinations of symbols appearing in predetermined portions of the array. The set of symbols includes one or more wildcards which can be substituted for any other symbol in the set in order to form a winning combination. The machine also includes a means adapted to increase the winnings normally paid on any winning combination, should that combination include a wildcard.

The Bennett patent is directed to a slot machine having a wildcard, which wildcard has a value that randomly ranges from 1 to 6 and multiplies the value of a payline. Further, the Bennett patent is directed to a slot machine game according to which a special feature is activated upon the occurrence of a certain symbol appearing in a left column at the same time as another certain symbol appears in a right column. The special feature in the Bennett patent is referred to as a wildcard. Upon activation of the special feature, a die is displayed on the game screen, moves around the screen, and stops either automatically or in response to user input. A winning is paid if a predetermined winning combination results from the physical proximity of the die and another symbol. In addition, the die may include a feature that multiplies the awarded payoff. It

is neither taught nor inferable that this "wildcard" feature operates by substituting for other symbols.

By contrast, the present invention teaches wildcards that are displayed automatically, and not in response to user input. Further, in accordance with principles of the present invention, wildcards do in fact operate as substitutes for other symbols and create winning combination according to those substitutions.

Thus, the Bennett patent does not disclose any wildcard that functions in the manner contemplated by the present invention. Claim 1 includes the limitation of "at least one wildcard which can be substituted for any other symbol." As such, Applicant respectfully submits that claim 1, as well as claims 2 and 5 which depended therefrom, are not anticipated by the Bennett patent.

Moreover, claim 1, as well as claims 2 and 5, which depended therefrom, are even further removed from any teachings of Bennett patent as there is no suggestion or motivation to use a wildcard as described in the Bennett patent as a substitute for another symbol to produce a winning combination as claimed. Concisely, a wildcard, as described in the Bennett patent, merely acts a multiplier for a combination of symbols that has already produced a winning result. Reconsideration and allowance of claim 1, as well as claims 2 and 5 which depend therefrom, are therefore respectfully requested.

Turning next to independent claim 10, recited is a method for operating a gaming machine. The method includes displaying an array of symbols randomly selected from a set of symbols and paying winnings on an occurrence of predetermined winning combinations of symbols appearing in predetermined portions of the array. The set of symbols includes one or more wildcards which can be substituted for any other symbol in the set in order to form a winning combination. Additional winnings are paid on those winning combinations that include a wildcard.

Thus, claim 10 is similar to claim 1, but written from the perspective of a method for operating a gaming machine. Claim 10 is also rejected under 35 U.S.C. 102(e) as being

anticipated by the Bennett patent. As discussed above in conjunction with claim 1, the use of a wildcard which can be substituted for any other symbol in the set in order to form a winning combination is not disclosed or suggested by the Bennett patent. Therefore, for reasons similar to those discussed above in conjunction with the rejections of claims 1, 2, and 5, Applicant respectfully submits that claim 10 is novel and non-obvious over the Bennett patent.

Reconsideration and allowance of claim 10, as well as claims 11 and 14 which depend therefrom, are therefore respectfully requested.

## **II. Rejection of claims 3, 4, 6-9, 12, 13, and 15-18 under 35 U.S.C. 103(a)**

The Examiner had concluded preliminarily that it is obvious to have more than one wildcard symbol, as generally recited in claims 3 and 12. Further, and also according to the Examiner, it is obvious to selectively place the wildcard symbols at adjacent positions in the array to graphically morph the symbols into one larger symbol, as generally recited in claims 4 and 13. The Examiner also believes that it is obvious that it would be obvious to provide a summation of all wildcards to achieve the multiplier value, as generally recited in claims 6-9 and 15-18.

First, since claims 3, 4, 6-9, 12, 13, and 15-18 depend either for claim 1 or claim 10, and, as described above, claims 1 and 10 are novel and non-obvious over the art of record, the rejections of claims 3, 4, 6-9, 12, 13, and 15-18 become moot. Therefore, reconsideration and allowance of claims 3, 4, and 6-9 which depend from claim 1 and claims 12, 13, and 15-18 which depend from claim 10 are therefore respectfully argued.

Further, notwithstanding claims 1 and 10 being novel and non-obvious, those features recited in claims 3, 4, 6-9, 12, 13, and 15-18 are independently novel and even further-removed from the art of record. For instance, the Examiner has been unable to provide and reference or supporting document that discloses those features of the present invention as recited in claims 3, 4, 6-9, 12, 13, and 15-18, making those features obvious. It is submitted that the subject combinations rely on hindsight having the benefit of the present disclosure. Such a reliance on

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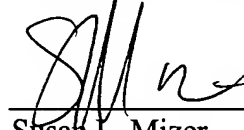
hindsight is impermissible. Therefore, reconsideration and allowance of claims 3, 4, 6-9, 12, 13, and 15-18 are respectfully argued.

In summary, Applicant respectfully submits that all pending claims are novel and non-obvious over the prior art of record. Reconsideration and allowance of all pending claims are therefore respectfully requested. If the Examiner believes there are any further matters which need to be discussed in order to expedite the prosecution of the present application, the Examiner is invited to contact the undersigned.

The Applicant is including PTO Form 2038 to cover the \$110.00 fee for a one month extension. If there are any other fees necessitated by the foregoing communication, please charge such fees to our Deposit Account No. 50-0902, referencing our Docket No. (76867/16445).

Respectfully submitted,

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**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8**

I hereby certify that this correspondence (along with any paper referenced as being attached or enclosed) is being deposited on the below date with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Date: \_\_\_\_\_

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